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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,411	03/24/2004	Frank Muir	08740001AA	3860

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WHITHAM, CURTIS & CHRISTOFFERSON, P.C.
11491 SUNSET HILLS ROAD
SUITE 340
RESTON, VA 20190

EXAMINER

DANIELS, MATTHEW J

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 06/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/807,411

Applicant(s)

MUIR, FRANK

Examiner

Matthew J. Daniels

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,7-11,17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,7-11,17 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. By entry of the amendment filed 17 March 2006, Claims 1-4, 7-11, 17, and 18 are pending. Claims 1, 7-11 were amended and Claims 17 and 18 are new.

Election/Restrictions

2. Applicant's election of Group I in the reply filed on 17 March 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 1-4, 7-11, 17 and 18** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. "based on" has an indefinite meaning because it imparts no particular relationship and it is unclear how this term is to be interpreted.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1732

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-3, 7, 8, 9, 10, 11, 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Owens (USPN 2635289). The Examiner submits that Owens' annular shape is suitable for engaging a bottle, and therefore meets all intended use limitations drawn to engaging of bottles or serving as a bottle cap. **As to Claim 1**, Owens teaches: A method of making a bottle cap with a built-in magnification feature (Figs. 20-30), comprising the steps of selecting a radius of curvature (inherent in that a radius is provided), pressing a single piece of plastic (Figs. 62, 63, see "a plastic sheet" at 3:26) into the shape of a bottle cap having a top portion (Fig. 30, Items 284,281) and an annular bottle engaging portion (Fig. 30, Items 286,285) which includes thread engaging members for selectively affixing the bottle cap to a top of a bottle, wherein said at least one of said upper or lower convex surfaces of each bottle cap has a radius of curvature (many of the elements of Owens would have a radius so as to magnify, see the figures) so as to provide optical magnification of objects through said top portion.

Although Owens does not explicitly disclose different radiuses (radii) being selected, Owens clearly instructs the ordinary artisan to provide a "size and shape wanted in the finished element" at 32:30-31. The Examiner asserts firstly that the intention of producing multiple parts having multiple shapes provides no material limitation to the method of making because it is the same method that would be practiced in each case, and additionally that Owens clearly suggests that one select the size and shape. **As to Claim 2**, Owens teaches the pressing step is achieved using a stamping machine (Figs. 1 and 2). **As to Claim 3**, Owens teaches the annular bottle

Art Unit: 1732

engaging portion includes thread engaging members (Fig. 30). **As to Claim 7**, by the multitude of elements shown in the figures of Owens, it is asserted that Owens clearly recognizes the particular radii of curvature to be a result-effective variable which can be modified and optimized. Additionally, Owens teaches that the upper and lower surfaces are convex and have an equal radius of curvature (Figs. 25 and 40, for instance). **As to Claim 9**, Owens teaches a flat surface and a convex surface (Fig. 20). Although silent to the top and bottom surfaces, this is a matter of orientation, and Owens' Fig. 20 meets the claimed limitation. **As to Claims 10 and 11**, Owens teaches plastic as an optical lens, which would have inherently have been transparent and translucent (Title, 4:14, 11:69-12:33). These terms appear to overlap in scope. **As to Claim 18**, Owens' process is simultaneous, and forms one or two convex surfaces (see the figures).

5. **Claim 4** is rejected under 35 U.S.C. 103(a) as being unpatentable over Owens (USPN 2635289) in view of Towns (USPN 2669369). Owens teaches the subject matter of Claim 1 above under 35 USC 103(a). **As to Claim 4**, Owens teaches compression molding, but is silent to a bottle-engaging portion that includes a lid wall with an inwardly projecting hook region at its base. However, this aspect is taught by Towns (Figs. 1-6). It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Towns into that of Owens because a) Owens suggests that a means for fixedly mounting the lens be provided (20:46-48) and Towns provides means for fixedly mounting (Fig. 3), and b) Towns suggests compression molding (2:9), which Owens provides (entire document).

6. **Claim 17** is rejected under 35 U.S.C. 103(a) as being unpatentable over Owens (USPN 2635289) in view of Harris (USPN 4401434). Owens teaches the subject matter of Claim 1 above under 35 USC 102(b). As to Claim 17, Owens appear to be silent to the particular configuration, however, the Examiner takes the following positions: Firstly, the Examiner asserts that this limitation is drawn to the particular size and shape, which do not materially affect the method and should be given little patentable weight. Secondly, the Examiner asserts that Harris provides a lens having convex surfaces and a perimeter which extends to an edge of the annular bottle engaging portion (Fig. 5, items 64, 28, and 12). It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Harris into that of Owens in order to provide a kit which is easy to manufacture and market (2:12-14), adapted for easy storage and maintenance of all the components needed in a single location (2:1-11), maintaining the viewer in a convenient position (2:29-40), and providing the largest possible magnifier in the lid to maximize the effect of the invention.

Response to Arguments

7. Applicant's arguments filed 17 March 2006 have been fully considered but they are not persuasive. Applicant's arguments appear to be on the following grounds:

- a) Owens teaches no bottle caps, uses laminated materials, and the intended use of Owens' article is different
- b) Owens in no way teaches a translucent material. Transparent has a contrasting definition with translucency.

Art Unit: 1732

- c) The combination of Owens and Towns is improper hindsight, there is no suggestion to combine.
- d) Owens does not suggest the simultaneous formation
- e) Harris does not form the cap from a single piece of plastic

These arguments are not persuasive for the following reasons or are addressed by the rejections above:

- a) The Examiner asserts that the *method* is at issue in this case. While limitations to the structure and shape have been considered, the Examiner asserts that they do not, without more, distinguish this method from other methods containing the same stepwise limitations. Moreover, the Examiner asserts that for the reasons set forth in the rejections above, that specific shapes which read on the instant invention are disclosed by Owens. The Examiner asserts that because the article of Owen could be used as a bottle cap, thus fulfilling the claimed intended use, that this limitation does not patentably distinguish the two *methods*.
- b) Applicant's provided definition of "translucent" includes as its second definition "2 transparent." The Examiner asserts that any alleged distinction between the terms has not been made clear, and does not distinguish the invention.
- c) In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's

Art Unit: 1732

disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Applicant has not argued specifically the motivation set forth above, and thus it is still believed to be valid.

d) The Examiner notes that while Owens does teach multipart fabrication in some embodiments (Fig. 64), that the method is clearly not limited thereto. See the teaching of the portions being “integral” (3:32) and Owens’ teaching a single material (denoted by the single hash material in the cross section of the lens) formed by the punch system in Figs. 1 and 2.

e) In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Owens clearly teaches a single piece of plastic, and Harris provides a particular configuration.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

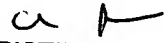
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Daniels whose telephone number is (571) 272-2450. The examiner can normally be reached on Monday - Friday, 8:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on (571) 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1732

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJD 5/31/06


CHRISTINA JOHNSON
PRIMARY EXAMINER
6/5/06